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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,145	04/14/2004	Daniel James Winarski	TUC920040007US1	7857

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EXAMINER
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KROFCHECK, MICHAEL C

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/825,145

Applicant(s)

WINARSKI ET AL.

Examiner

Michael Krofcheck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/7/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to application 10/825,145 filed on 4/14/2004.
2. Claims 1-18 have been submitted and examined.

#### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it contains the phrase, "Disclosed are a..." as it is clear that the information being presented is being disclosed.

Correction is required. See MPEP § 608.01(b).

#### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 15-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-18 is not limited to tangible embodiments. In view of the applicant's disclosure, specification page 18, paragraph 00049, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., volatile and non-volatile memory) and intangible embodiments (e.g., signals propagating through space, radio waves, infrared signals). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-3, 5-8, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis, US patent 5659801 and Bolt, US patent application publication 2002/0144048.

11. With respect to claims 1 and 6, Kopsaftis teaches of a method for updating microcode, comprising the steps of: assigning a first LUN to a first device (fig. 1; column 5, lines 29-37; where the commands directed to the disk drive, 10 are received by the bus interface as they contain the same LUN as stored in the bus interface. Thus the disk drive device must have been assigned a LUN);

said first device receiving one or more commands (fig. 1; column 5, lines 29-37; where the commands directed to the disk drive, 10 are received by the bus interface as they contain the same LUN as stored in the bus interface);

said first device obtaining a LUN address from each of said one or more commands (fig. 1; column 5, lines 29-37; where the commands directed to the disk drive, 10 are received by the bus interface as they contain the same LUN as stored in the bus interface); and

Bolt teaches of a data transfer LUN for a storage drive and a management configuration LUN for the microbridge controlling the drive (paragraph 0066).

The combination of Kopsaftis and Bolt teaches of assigning a second LUN to a memory (In the combination, the non-volatile memory grouped with the RAM involved in managing the disk drive (Kopsaftis, fig. 1, item 108, column 3, lines 47-52) is assigned a LUN, taught in Bolt paragraph 0066);

in response to said LUN address obtained from each of said one or more commands being equal to said second LUN, processing each of said one or more commands to update said microcode in said memory (Kopsaftis, fig. 1, 3; column 5, lines 29-37, column 8, line 63-column 9, line 2; as the initiator command would contain the LUN for the disk management area (second LUN) as each command contains the respective LUN).

It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis and Bolt at the time of the invention to assign the non-volatile memory and resident RAM within the disk drive a LUN for management in Kopsaftis as taught in Bolt. Their motivation would have been to simplify the processing of sending separate management and data I/O commands over the same interface.

12. With respect to claim 2, Kopsaftis teaches of in response to said LUN address obtained from each of said one or more commands being equal to said first LUN, processing each of said one or more commands as input/output commands of said first device (fig. 1; column 5, lines 29-37, 47-62).

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13. With respect to claim 3, Kopsaftis teaches of in response to said first device receiving a prepare for microcode update command, placing said first device in a operational state to receive said update of said microcode (column 8, lines 63-65).

14. With respect to claim 5, Kopsaftis teaches of wherein said processing each of said one or more commands to update said microcode further comprises: overwriting a memory associated with said first device with an updated microcode (fig. 3, item 236; column 10, lines 25-37).

15. With respect to claim 7, Kopsaftis teaches of a host, wherein said host sends microcode update commands to said first device (fig. 1; item 20; column 1, lines 25-29, column 3, lines 32-43).

16. With respect to claim 8, Kopsaftis teaches of a host (fig. 1; item 20; column 3, lines 32-43); and

a device interface coupled to said host wherein said device interface receives commands from said host and transfers said commands to LUN addressable components (fig. 1; item 40; column 3, lines 32-43; column 3, line 66-column 4, line 3; as the commands are sent to the disk drive (LUN addressable components) from the host, it must be done through the SCSI interface as it is the only connection between the two).

17. With respect to claim 10, Kopsaftis teaches of wherein said memory is coupled to said first device (fig. 1, items 108, 10; where the memory 108 is connected to the bus interface and all the other components of the disk drive, thus being coupled to the disk drive (first device)).

18. With respect to claim 12, Kopsaftis teaches of a second device removably attached to said first device, wherein said memory is coupled to said second device (fig. 1; item 60; where the SCSI bus, 60, is attached to the disk drive. It is abundantly clear to one of ordinary skill in the art that the bus is removably attached to the disk drive, as disk drives the cables connecting them to the bus can be disconnected from the each other in a computer. As such the non-volatile memory, 108 is attached to it through the bus interface).

19. With respect to claim 13, Kopsaftis teaches of a controller for operating said first device, wherein said memory is coupled to said controller (fig. 1; items 106, 112).

20. With respect to claim 14, Kopsaftis teaches of wherein said system is an automated data storage library (fig. 1).

21. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Bolt as applied to claim 1 above, and further in view of Shirasawa et al., US patent application publication 2002/0166027.

22. With respect to claim 4, Shirasawa teaches of wherein said placing said first device is a operational state to receive said update of said microcode further comprises: not accepting any new commands for processing; completing all current commands (fig. 3, paragraph 0038-0039; where the I/O process to the hard disk A is stopped. It is abundantly clear to one of ordinary skill in the art that the command currently being executed are finished as if they were abruptly stopped, that can result in corrupting the data on the drive); and



placing movable components at a rest position (fig. 3, paragraph 0038-0039; It is abundantly clear to one of ordinary skill in the art that as all access to the drive has stopped and that a reboot of the drive will be necessary upon completion of the firmware update, initially powering down the spindle motor, arm, etc. would conserve considerable power while the firmware is being updated).

It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis and Bolt, and Shirasawa at the time of the invention to enable the transferring of I/O processing to another drive when updating the firmware of a specific drive in the combination of Kopsaftis and Bolt as taught in Shirasawa. This would enable current I/O processing to continue uninterrupted (Shirasawa, paragraph 0012).

23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Bolt as applied to claim 6 above, and further in view of Pellegrino et al., US patent application publication 2004/0225775.

24. With respect to claim 9, Pellegrino teaches of wherein said memory is an Electrically Erasable Programmable Read Only Memory (paragraph 0030).

It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis and Bolt, and Pellegrino at the time of the invention to make the non-volatile memory of the combination of Kopsaftis and Bolt an EEPROM as taught in Pellegrino as numerous devices have embeded their firmware in EEPROM so that it can be updated, and will not be lost when power is removed from the memory (Pellegrino, paragraph 0030).

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25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis and Bolt as applied to claim 6 above, and further in view of Abbott et al., US patent 6205093.

26. With respect to claim 11, Abbott teaches of further comprising an accessor, wherein said memory is coupled to said accessor (fig. 2; item 18; column 4, lines 18-35).

It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis and Bolt, and Abbott at the time of the invention to store and update the microcode of Abbott in a non-volatile memory as taught in the combination of Kopsaftis and Bolt, implementing the microcode updating method in a tape system as Kopsaftis teaches of the system also using tapes, column 1, lines 6-24. This would simplify the processing of sending separate management and data I/O commands over the same interface in the tape system and provide increased speed by using a solid state memory over a disk drive to store the microcode in.

27. Claims 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis, Bolt, and Burton et al., US patent 6393535.

28. With respect to claim 15, the combination of Kopsaftis, Bolt teaches of all the limitations cited above with respect to claims 1 and 6. Burton teaches of an article of manufacture comprising a data storage medium tangibly embodying a program of machine-readable instruction executed by a processing apparatus to perform method steps (column 9, lines 35-53).

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It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis, Bolt, and Burton at the time of the invention to implement the method steps from the combination of Kopsaftis and Bolt in the information bearing media of Burton. Their motivation would have been to allow for the process to be easily transferred and implemented on different computer systems.

29. With respect to claims 16 and 17, the combination of Kopsaftis and Bolt teaches of the limitations cited with respect to claims 2 and 3 respectively.

30. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kopsaftis, Bolt, and Burton as applied to claim 15 above, and further in view of Shirasawa.

31. With respect to claim 18, Shirasawa teaches of the limitations cited above with respect to claim 4.

32. It would have been obvious to one of ordinary skill in the art having the teachings of Kopsaftis, Bolt, Burton, and Shirasawa at the time of the invention to enable the transferring of I/O processing to another drive when updating the firmware of a specific drive in the combination of Kopsaftis, Bolt, and Burton as taught in Shirasawa. This would enable current I/O processing to continue uninterrupted (Shirasawa, paragraph 0012).

### ***Conclusion***

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Krofcheck whose telephone number is 571-272-8193. The examiner can normally be reached on Monday - Friday.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael C. Krofcheck



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